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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALBERT ANDREW MURRER III

Appeal 2008-1407
Application 10/629,322
Technology Center 3700

Decided: January 23, 2009

Before TONI R. SCHEINER, DONALD E. ADAMS, and ERIC GRIMES,
Administrative Patent Judges.

ADAMS, *Administrative Patent Judge.*

DECISION ON REQUEST FOR REHEARING

Appellant has requested rehearing (reconsideration) of the Decision entered September 30, 2008. That Decision affirmed the Examiner's rejection of claims 6-10, 12-19, and 25 as obvious under 35 U.S.C. § 103. We have jurisdiction under 35 U.S.C. § 6(b).

Claim Interpretation:

ISSUE

Does the term ‘soft-sided’ mandate that the claimed container system collapse in a manner that produces an unorganized reduction in volume?

FACTS

FF 1. Appellant’s Specification defines the term “soft-sided” as referring “to a non-rigid characteristic. ‘Soft-sided’ may include a surface that can be, for example, bent or folded, either easily or with relatively little force” (Spec. 3: ¶ 0009; Decision 11-12).

FF 2. Appellant’s Specification defines the term “collapsible” as meaning the ability to occupy less volume. “Collapsible” may include an organized reduction in volume through folding, for example, and may also include an unorganized reduction, as may occur with an unsupported structure. “At least partially” collapsible refers to the ability to collapse at least part of the way between a fully assembled configuration and a fully collapsed configuration.

(Spec. 3: ¶ 0011.)

PRINCIPLES OF LAW

During examination, the PTO must interpret terms in a claim using “the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant’s specification.” *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

ANALYSIS

Appellant contends that “the requirement in all pending claims that the outer shell be ‘soft-sided’ mandates that ‘collapsible’ include ‘an unorganized reduction’ in volume” (Req. Reh’g 5 (emphasis removed)). We disagree.

While the term soft-sided refers to a non-rigid characteristic, which may include a surface that can be bent or folded easily or with relatively little force, there is no requirement in Appellant’s definition of the term that “mandates” the term soft-sided be interpreted as collapsing in a manner that results in an unorganized reduction in volume as may occur with an unsupported structure (FF 1). Further, while the term collapsible *may* include the unorganized reduction in volume as may occur with an unsupported structure, Appellant’s definition of the term collapsible does not *require* an unorganized reduction in volume (FF 2). To the contrary, Appellant’s definition of the term collapsible presents two alternatives: (1) an organized reduction in volume through folding; or (2) an unorganized reduction as may occur with an unsupported structure (*id.*).

Therefore, when the terms “soft-sided” and “collapsible” as defined by Appellant are read together one finds that a soft-sided structure that is bent or folded, either easily or with relatively little force, reads on a soft-sided structure that collapses in a manner that produces an organized reduction in volume through folding, or in Appellant’s words: “a pre-determined volume reduction pattern” (Req. Reh’g 5).

Accordingly, we are not persuaded by Appellant’s contention that the term “‘soft-sided’ mandates that ‘collapsible’ include ‘an unorganized reduction’ in volume” (Req. Reh’g 5 (emphasis removed)).

CONCLUSION OF LAW

The term ‘soft-sided’ *does not* mandate that claimed container system collapse in a manner that produces an unorganized reduction in volume.

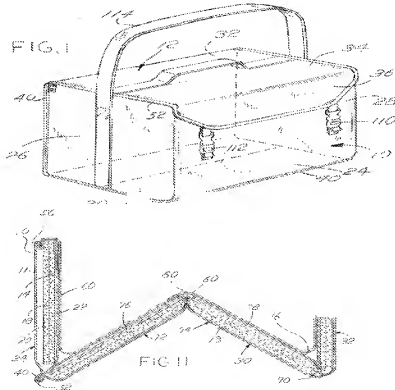
Redzisz:

ISSUE

Does Redzisz teach a container with a soft-sided outer shell?

FINDINGS OF FACT

FF 3. “Redzisz teaches ‘[a] collapsible insulated cooler case [which] includes a sandwich construction of fabric and cell foam material forming the panel walls of the container’” (Decision FF 1). “For clarity, we reproduce Redzisz’s figures 1 and 11 below:



‘**FIG. 1** is an isometric view of the case in the closed, yet fully assembled, condition or mode’” (*id.*). “‘**FIG. 11** is a cross sectional enlarged view of the bottom side and front and back side construction of the case’ in a partially collapsed condition” (*id.*).

FF 4. “Redzisz teaches that ‘[t]he flexible fabric sections, or subsections, **10** and **12** may be fabricated from plastic materials, fabric materials, or any similar flexible sheet material’” (Decision FF 2).

PRINCIPLES OF LAW

Where “the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the Patent and Trademark Office can require [an] applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product.” *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977).

ANALYSIS

Appellant contends that

[t]he generic description in Redzisz that the container is made of foam cell material encased in fabric gives no indication of whether the container has rigid walls or is soft-sided. In order to make this determination, one must look beyond the generic description of construction materials and into the specific teachings of Redzisz.

(Req. Reh’g. 6.) Reviewing Redzisz’ figures, Appellant contends that “[n]othing in the[] figures indicates soft-sidedness” (*id.*). Appellant contends that “each of the Redzisz embodiments are depicted with sharp

score lines or stitches to define a folding line” (*id.*). Appellant contends “that the use of the term ‘collapsible’ by Redzisz . . . is not equivalent to ‘collapsible,’ as defined by Appellant. Instead, the Redzisz container is more properly described as a ‘foldable’ container” (Req. Reh’g 7). Appellant contends that “[f]olding is an ‘organized reduction’ in volume only, which does not satisfy Appellant’s requirement for ‘partially collapsible,’ as that term is used in the context of a soft-sided outer shell” (Req. Reh’g 8). “In sum, [Appellant contends] there is no example or indication in Redzisz of a container in which the sides themselves are capable of being ‘bent or folded, either easily or with relatively little force’ in a disorganized manner” (Req. Reh’g. 6-7). We are not persuaded.

Appellant concedes that Redzisz teaches lines or stitches that define fold lines (Req. Reh’g. 6). As discussed above, there is no requirement in Appellant’s claimed invention that the container system be bent, folded, or otherwise collapsed in a disorganized manner, or in a manner that results in an unorganized reduction of volume.

In addition, “Redzisz teaches that ‘[t]he *flexible* fabric sections, or subsections, **10** and **12** may be fabricated from plastic materials, fabric materials, or any similar *flexible* sheet material’” (FF 4 (emphasis added)). Appellant has not established that Redzisz’ *flexible* fabric sections or sheet material does not result in a soft-sided container according to Appellant’s claimed invention.

Further, we disagree with Appellant’s intimation that the description of Redzisz’ invention should be limited solely to Redzisz’ figures (Req. Reh’g. 6).

Redzisz teaches that “[t]he flexible fabric sections, or subsections, **10** and **12** may be fabricated from plastic materials, fabric materials, or any similar flexible sheet material” (FF 4).

Redzisz teaches “[a] collapsible insulated cooler case [which] includes a sandwich construction of fabric and cell foam material forming the panel walls of the container” (FF 1). There is no evidence on this record to suggest that the fabric and cell foam construction of Redzisz’ container does not result in a soft sided outer shell as defined by Appellant.

(Decision 12.) Accordingly, we disagree with Appellant’s contention that “[t]he ability to maintain structural integrity in the fully opened configuration is inconsistent with a soft-sided container” (Req. Reh’g 7). Appellant defines the term “soft-sided” as including “a surface that can be, for example, bent or folded, either easily or with relatively little force”, e.g., a flexible surface (FF 1). There is no evidence on this record to demonstrate that Redzisz’ fabric and cell foams container does not result in a surface that can be bent or folded either easily or with relatively little force.

Appellant failed to demonstrate that Redzisz’ container does not result in a soft sided outer shell as defined by Appellant. *In re Best*, 562 F.2d at 1255.

CONCLUSION OF LAW

The preponderance of the evidence on this record supports the conclusion that Redzisz teaches a container with a soft-sided outer shell.

Zeddies:

ISSUE

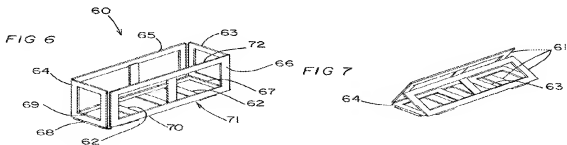
Does Zeddies require a substantially rigid wall?

FACTS

FF 5. “Zeddies teaches that ‘[e]ach of the walls **11** may comprise a layer of a thermal-retentive material **30**. The thermal-retentive material **30** may comprise a flowable gel material. Each of the walls **11** may comprise a substantially rigid panel **31** positioned adjacent to the thermal-retentive material **30**’” (Decision FF 6).

FF 6. “Zeddies teaches that a bend line ‘is formed between the end regions of the walls mounted together . . . to allow bending . . . for permitting adjacent walls **22, 23, 24, 25** on opposite sides of the bend line . . . to be folded into an adjacent condition’” (Decision FF 7).

FF 7. “Zeddies teaches a frame [adapted] to fit in the interior of the walls when they are oriented perpendicular to the bottom wall” (Decision FF 8). “Zeddies teaches that the frame panels **63-66** are pivotally mounted on the bottom frame panel to allow the frame panels to fold” (*id.*). “For clarity, we reproduce Zeddies’ FIGs 6 and 7 below:



“FIG. 6 is a schematic perspective view of the plurality of frames of . . . [Zeddies’] invention shown in condition for use. FIG. 7 is a schematic

perspective view of the plurality of frames shown in a stored configuration” (*id.*).

PRINCIPLES OF LAW

Obviousness is viewed through the lens of a person of ordinary skill in the art with consideration of common knowledge and common sense.

Dystar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co., 464 F.3d 1356, 1367 (Fed. Cir. 2006).

ANALYSIS

Appellant asserts that “the only volume reduction mechanism contemplated [by Zeddies] is a folding mechanism, consistent with substantially rigid outer walls” (Req. Reh’g. 9). In this regard, Appellant contends that “while the substantially rigid panel 31 may be optional, Zeddies provides no indication that the walls as a whole should not maintain a substantially rigid character” (*id.*). Appellant does not, however, identify any teaching in Zeddies or provide any evidence that a person of ordinary skill in the art would reasonably expect that in the absence of substantially rigid panel 31, the walls of Zeddies’ container would retain a substantially rigid character.

CONCLUSION OF LAW

The preponderance of evidence on this record fails to establish that Zeddies requires a substantially rigid wall.

The combination of Redzisz and Zeddies:

ISSUE

Would it have been prima facie obvious to a person of ordinary skill in the art at the time the invention was made to use Zeddies' frame in Redzisz's container?

FINDINGS OF FACT

FF 8. We previously found that:

Both Redzisz and Zeddies teach a collapsible container that can retain some shape when in the open configuration (*see, e.g.*, FF 1 and 5). Such a configuration is not excluded from Appellant's definition of a non-rigid, soft-sided container which "may include a surface that can be, for example, bent or folded, either easily or with relatively little force" (Spec. ¶ 0009).

Zeddies teaches that the walls of the container *may* comprise a "substantially rigid panel" (FF 6), which according to Appellant's assertions would further maintain the container's shape in the open position. Nevertheless, Zeddies teaches the use of a frame that fits in the interior of the walls when they are oriented perpendicular to the bottom wall (FF 8). Stated differently, even if one of ordinary skill in this art would make use of Zeddies' substantially rigid panel for use in the construction of the container's walls, Zeddies teaches the use of an inner frame to support the container.

There is, however, no requirement in Zeddies that a relatively rigid material be used for the walls. There is also no evidence on this record that Redzisz's container does not result in a soft sided outer shell as defined by Appellant. Therefore, as a whole, we find Appellant's arguments unpersuasive.

(Decision 12-13.)

PRINCIPLES OF LAW

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, ___, 127 S. Ct. 1727, 1739 (2007).

ANALYSIS

Appellant contends that “there is no motivation to use an internal frame with containers that have sufficient structural strength and rigidity for the desired purpose” (Req. Reh’g 11). In this regard, Appellant contends that “generally, an internal frame is placed inside a container when the container lacks the requisite structural rigidity or strength for the desired purpose” (*id.*). We are not persuaded.

Appellant’s contention is inconsistent with Appellant’s interpretation of Zeddies. Specifically, Appellant contends that “Zeddies provides no indication that the walls as a whole should not maintain a substantially rigid character” (Req. Reh’g 9), yet Zeddies teaches the use of an inner frame (FF 7). Appellant contends that “the use of an internal fram[e] in Zeddies is motivated by its loosely-secured sidewall design, maintained with Velcro straps. Thus, the requisite motivation is negated because the Redzisz container is capable of maintaining its structure” (Req. Reh’g 11). We disagree.

Redzisz’s container is composed of “flexible fabric sections, or subsections, **10** and **12** [that] may be fabricated from plastic materials, fabric materials, or any similar flexible sheet material” (FF 4). Contrary to Appellant’s intimation, a person of ordinary skill in the art would recognize

that a frame as taught by Zeddies would enhance the structural strength and rigidity of Redzisz's container. "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR*, 550 U.S. at ___, 127 S. Ct. at 1739.

CONCLUSION OF LAW

It would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to use Zeddies' frame in Redzisz's container.

Redzisz, Zeddies, and Travis:

ISSUE

Did our analysis of the rejection of claims 17-19 under 35 U.S.C. § 103 as unpatentable over the combination of Redzisz, Zeddies, and Travis result in a new ground of rejection?

FINDINGS OF FACT

FF 9. The Examiner found that "[t]he use of the *container* disclosed by Travis . . . as a removable inner frame would provide a collapsible frame structure that would be less bulky and fold flat with a thinner profile for handling and storage than the frame of Zeddies" (Ans. 13 (emphasis added)). Our decision states that

Travis teaches an internal frame having side walls that are linked to the ends of longitudinal walls (Ans. 7; FF 17). The walls of Zeddies' frame are pivotally mounted on the bottom frame panel. Both the Zeddies and the Travis frames allow the frame to collapse into a conformation that reduces the distance between longitudinal walls (FF 8 and 17). There is no evidence

on this record to suggest that the pivotable mounts of Zeddies' frame could not be replaced with the wall linkages taught by Travis to accomplish the same purpose of allowing the frame to collapse in a manner that reduces the distance between the frame's longitudinal walls.

(Decision 22.)

PRINCIPLES OF LAW

A new ground of rejection occurs when the Examiner and the Board reject a claim for different reasons. *In re Kumar*, 418 F.3d 1361, 1368 (Fed. Cir. 2005), citing *In re Waymouth*, 486 F.2d 1058, 1060-61 (CCPA 1973).

"[T]he ultimate criterion of whether a rejection is considered 'new' in a decision by the board is whether appellants have had fair opportunity to react to the thrust of the rejection". *In re Kronig*, 539 F.2d 1300, 1302 (CCPA 1976).

ANALYSIS

Appellant contends that "the Board bases its affirmation of the rejection of claims 17-19 on an entirely different theory which requires a modification of the Zeddies inner frame based on the disclosure of Travis, rather than on the Examiner's argument for inserting the entire Travis frame (or container) into the Redzisz container" (Req. Reh'g 14; FF 9). On reflection, we agree with Appellant's contention.

CONCLUSION OF LAW

Our analysis of the rejection of claims 17-19 under 35 U.S.C. § 103 as unpatentable over the combination of Redzisz, Zeddies, and Travis resulted in a new ground of rejection.

SUMMARY

We reaffirm the rejection of:

- claims 6 and 12-15 under 35 U.S.C. § 103 as unpatentable over the combination of Redzisz and Zeddies;
- claims 7 and 8 under 35 U.S.C. § 103 as unpatentable over the combination of Redzisz, Zeddies, and Tattam;
- claim 9 under 35 U.S.C. § 103 as unpatentable over the combination of Redzisz, Zeddies, and Boyd-Moss;
- claim 10 under 35 U.S.C. § 103 as unpatentable over the combination of Redzisz, Zeddies, and Kalal;
- claim 16 under 35 U.S.C. § 103 as unpatentable over the combination of Redzisz, Zeddies, and Reichert; and
- claim 25 under 35 U.S.C. § 103 as unpatentable over the combination of Redzisz, Zeddies, and McHutchison.

For the reasons set forth above, we designate our affirmance of the rejection of claims 17-19 under 35 U.S.C. § 103 as unpatentable over the combination of Redzisz, Zeddies, and Travis as a new ground of rejection.

TIME PERIOD FOR RESPONSE

In addition to affirming the Examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the proceeding will be remanded to the Examiner....
- (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record....

Should the Appellant elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the Appellant elects prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences

Appeal 2008-1407
Application 10/629,322

for final action on the affirmed rejection, including any timely request for rehearing thereof.

REHEARING GRANTED-IN-PART

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